

REMARKS

Claims 1 and 3-23, as amended, are pending for the Examiner's review and consideration. In the specification, paragraphs [0012] and [0025] have been amended to correct a few minor typographical errors and a grammatical error. Claims 1 and 22 were amended to specify that the filling is a *fat-based* confectionary filling. Support for this feature is found in paragraphs [0001] and [0006] of the Specification, as well as in claims 8, 10 and 23. As no new matter has been added by these amendments, all claims are in condition for entry at this time.

Claims 10 and 22-23 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action alleges that the process in claim 23 is not supported by the specification. The Office Action maintains that there is no disclosure in the specification that a portion of the mass flows to conform to the shape of the sugar wafer (Office Action, page 2). The Office Action has mistakenly stated that there is no disclosure of modifying the viscosity and shape of the wafer to cause the mass to conform to the shape, or that the shape is sufficiently solid under ambient temperature (*Id.*). Importantly, the Office Action appears to misunderstand the invention in this rejection. In relevant part, claim 23 recites providing a substantially water-free fat-based confectionery in a molten mass upon or into the shaped sugar wafer so that a portion of the mass flows to conform to the shape of the sugar wafer. Thus, the Office Action appears to mistake the wafer itself as being the mass that is flowing and conforming. On the contrary, it is the substantially water-free fat-based confectionery that is in a molten mass that flows and conforms to the shape of the wafer. Thus, the "viscosity and shape of the wafer" will have minimal effect on the properties of the molten mass of confectionery. Support that a portion of the mass flows and conforms to the shape of the sugar wafer is inherently disclosed based on the confectionery materials disclosed and the fact that these materials harden or solidify sufficiently to retain a desired shape, such as the dome shape disclosed in the Examples (*See* Specification, paragraphs [0019] and [0020]; Examples 1-3).

Furthermore, the Office Action alleges that the feature of claims 22-23 is not supported in the specification because the specification does not disclose any temperature with respect to the confectionary mass solidifying (*Id.*). Although no reasons were provided for the rejection of claim 10, Applicants assume that it was rejected for the same reason recited for claims 22-23.

The Office Action is correct that this identical language is not explicitly present *ipsissimus verbis*. That strict requirement, however, is not the test for whether claim language is sufficiently enabled.

Before even reaching the alleged merits of this rejection, Applicants respectfully submit that the burden is on the Patent Office to demonstrate lack of possession of the invention in the claim terms. MPEP § 2163.04.¹ The Patent Office has failed to do so here, where examination of the application as a whole provides clear and unambiguous support for the specific words now recited in the claims. A typical fat-based confectionary material, chocolate, is well known to be able to melt and flow at one temperature, and then set after cooling to take the shape of the cavity into which it flows. It is patently clear from the present specification that a portion of the mass flows to conform to the sugar wafer when provided into the wafer, since the mass is added in molten (including semi-solid or semi-liquid) form. These states of matter all involve a flowable material, as is well understood by those of ordinary skill in the art, that then hardens or solidifies in place after it is provided to the sugar wafer. Hardened materials then retain their shape, particularly when they are disposed in a cavity or "container" like the presently recited shaped sugar wafer, as is also well understood by those of ordinary skill in the art.

The Patent Office has not provided any basis on the written record to suggest that those of ordinary skill in the art are unaware that various confectionery materials solidify under ambient conditions or temperatures. Moreover, the Patent Office has improperly ignored the Couzens Declaration in this regard. It provides the written conclusion of one of ordinary skill in the art that "[I]t is clear . . . that ambient conditions are used when nothing else is specified." (Couzens Declaration, ¶ 6). The Office Action makes bald assertions that the "conclusion without support of factual evidence" of the Declaration can somehow be ignored. There is, however, nothing in the written record to suggest that anything is incorrect about the conclusion in the Couzens Declaration.

Furthermore, even if the Patent Office had met its burden to rebut the presumption the description as filed is adequate, and even if the Patent Office had overcome the contrary evidence from the Couzens Declaration that the language "ambient conditions" is

¹ A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. *See, e.g., In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97.

well understood, the Office Action appears to overlook several other aspects in its improper lack of possession of the invention-type rejection. As is well known, mere rephrasing of a passage in a claim does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973); *see* MPEP § 2163.07. Applicants have simply reworded features specifically disclosed in the specification in an expected and well-understood manner to those of ordinary skill in the art in an attempt to make the claims more clearly and distinctly recite the invention. No new meaning is intended by rewording the features of the application and making them into perfectly acceptable claim amendments, and this is permissible under Federal Circuit case law as well as the Patent Office's own practices and procedures such as stated in the MPEP.

Indeed, by disclosing in a patent application a material that inherently performs a function or has a property, operates according to a theory, or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be properly amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973); *see* MPEP § 2163.07(a). Moreover, there is no inconsistency between the amended claim language and the specification, such that this cannot be the basis of a proper rejection. MPEP § 2173.03.

Based on the proper interpretation of judicial decisions on this issue, as well as the MPEP, it is clear that the claim language is sufficiently supported by the specification and this rejection is not proper here. Specifically, it is clear that the terms "ambient condition" or "ambient temperature" are well understood by those of ordinary skill in the art, particularly in view of the Couzens Declaration. It is also clear to those of ordinary skill in the art, based on the well understood term "molten," that a molten, or heated confectionery mass at least partly reduced to the liquid state, is flowable (Specification, paragraph [0019]) (Couzens Declaration, ¶ 6). Flowability is a defining characteristic of conventional materials in liquid state. When a flowable mass is placed into a container, such as a shaped sugar wafer, some of the flowable mass (*i.e.*, the molten confectionery mass) will inevitably flow to conform to the shape of the sugar wafer (*Id.*). As noted above, chocolate can flow at elevated temperatures, and it will then flow into a cavity, mold or container to conform to its shape. This is elementary, and the Patent Office has not rebutted common sense or the Couzens Declaration on the written record. To answer the question posed in the Office Action, yes, a

creamy molten material will indeed flow to conform to even a flat wafer. The present invention, however, recites a shaped wafer. Thus, the claim recitation that a "portion of the mass flows to conform to the shape of the sugar wafer" is inherently supported, as well as being supported in the spirit of the specification (*Id.*). Further, the only way that a mass can move is either by flowing or by movement of the entire mass as a solid block. Since the application clearly supports that the mass is molten and is deposited into the shaped sugar wafers (*See, e.g.*, Examples 1-3), at least a portion of the confectionery mass presently recited must be flowable. This is readily understood by those of ordinary skill in the art, and is supported by original method claim 10, Examples 1-3, and the specification as a whole. As previously discussed, the burden is on the Patent Office to demonstrate lack of possession of the invention in the claim terms. MPEP § 2163.04.

Claims 10, and 22-23 were also rejected because the exact language "solid or hardened under ambient temperature" is not present word-for-word in the specification. Support for this claim language exists in the language "filling the sugar wafer with . . . molten, semi-liquid or semi-solid mass, and *allowing the filling to harden*" (Specification, paragraph [0019]). Applicants concede that no special temperature is disclosed in connection with this hardening of the filling, and thus, the conventional understanding--particularly to those of ordinary skill in the art in view of the specification--is that this hardening can and would result under ambient temperature. Claims 10 and 22 recite that the confectionery mass is solid or hardened under ambient temperature, while claim 23 recites that the mass is sufficiently solid to retain the desired shape (*e.g.*, a domed shape as expressly disclosed in the Examples), and each aspect of these features is at least inherently if not expressly supported by the specification. Indeed, the very word "allowing" suggests that something is permitted or allowed to naturally occur without further action, *i.e.*, the solidifying or hardening occurs without intervention such as active heating or cooling; what is left without intervention must inherently be under ambient conditions.

Applicants are not required by Section 112, first paragraph, to explicitly and expressly describe every single possible detail about an invention in an application. Rather, only the essential details of an invention must be described, and the remainder that are understood by those of ordinary skill in the art can be omitted as surplusage so that well understood concepts and details can be omitted to avoid having each application read as a textbook. Indeed, the Patent Office is again attempting to make this preference for shorter applications into law—through proposals to discourage lengthy specifications through additional filing fees. Those details that are understood by those of ordinary skill in the art

need not be expressly discussed or detailed in an application, which is the situation here with "ambient temperature" being understood.

Further, the specification contains three (3) examples, each of which indicates the filling hardens sufficiently to retain a desired dome shape after the sugar wafer is filled therewith. Given that no specific temperature is taught in these examples, those of ordinary skill in the art would have understood-- in the absence of further information--that the specification means that this hardening occurred under ambient temperature, *i.e.*, it was "allowed." It is disingenuous to allege that ambient temperature or ambient conditions are not even inherently present in the specification.

Since the claims are commensurate in scope with the ambient conditions, such as temperature, that are inherently and inevitably disclosed in the specification (Couzens Declaration, ¶ 6), Applicants have demonstrated possession of the claimed invention sufficiently to obviate the rejection, or at least to shift the burden to the Examiner of maintaining the rejection and rebutting the presumed-sufficient disclosure. MPEP § 2163.04. In view of the above, Applicants respectfully request that the features of claims 10 and 22-23 be fully considered. For these reasons, the rejection under 35 U.S.C. § 112, first paragraph, has been obviated and should be reconsidered and withdrawn.

Claims 1 and 3-23 were rejected under 35 U.S.C. § 103(a) as being obvious over WO 00/13512 to Conti et al. ("Conti") in view of U.S. Patent No. 4,948,602 to Boehm et al. ("Boehm"). The Office Action alleges on page 2 that Conti discloses sugar wafers, and that these wafers may have a variety of shapes and sizes. The Office Action further states that Example 1 discloses a wafer tube filled with a fat-based cream containing yoghurt. Boehm is alleged to disclose a filled cookie which contains an oil-based interior filling, the filling containing nut paste in combination with chocolate.

The Office Action on page 3, however, admits that Conti does not disclose the size, the inclusion of edible inclusions, the amount and type of vegetable fat in combination with chocolate and the material being solid or hardened under ambient temperature. The Office Action alleges that it would have been obvious to one skilled in the art to use any type of filling material, *i.e.* the filling of Boehm, in the wafers disclosed by Conti. Furthermore, the Office Action claims that the filling material claimed is known in the art as shown by Boehm. Applicants respectfully disagree.

Conti does disclose sugar wafers, but specifically mentions that wafers may be distinguished from biscuits/cookies (page 1, lines 21-22). Wafers are the result of baking a batter, while biscuits/cookies are baked out of a dough (*Id.*). "Batter normally has a water

content of more than 100 parts per 100 parts of flour and is a liquid suspension that will flow through a pipe whereas biscuit dough is rather stiff to permit rolling and flattening and has a water content of less than 50 parts per 100 parts of flour" (page 1, lines 22-25).

Boehm, on the other hand, discloses a baked filled cookie prepared from biscuit dough (Col. 3, lines 41-42). In fact, the biscuit dough taught by Boehm has a water content less than 50 parts per 100 parts of flour, which confirms the teaching of Conti that the two are different and distinguishable by those of ordinary skill in the art. For example, the vanilla biscuit dough of Boehm contains about 15 to 20 parts by weight of water, based on 100 parts by weight of flour (*See* Col. 5, lines 16-24). Similarly, the graham biscuit dough of Boehm contains about 15 to 20 parts by weight of water, based on 100 parts by weight of flour (*See* Col. 5, lines 50-58).

Conti teaches a different food product from Boehm and even particularly identifies the differences between a wafer and a cookie. Moreover, the cookie of Boehm is prepared from a dough that is explicitly referred to in Conti as different from a wafer. Thus, one of ordinary skill in the art would have had no motivation to combine the fillings of Conti with those of Boehm because the subject matter of the two patents is markedly different.

In addition, even if one of ordinary skill had been somehow motivated to combine Conti and Boehm, there would have been no reasonable expectation of success. Conti states that the sugar wafers may be used together with confectionary materials such as ice creams or chocolates or other *fatty materials* such as fat-based cream (emphasis added) (page 4, lines 15-17). Moreover, the confectionary materials are preferably of *low water activity* so that a minimum of moisture migration occurs (emphasis added) (page 4, lines 17-19).

In contrast, Boehm discloses both an oil-based filler and a water-based filler (Col. 1, lines 35-36). During heating of the cookie, the water-based filler exudes down the outer sides of the cookie, while the oil-based filler essentially remains within the cookie (Col. 3, lines 56-60). Boehm requires that both fillers be present in the cookie. "In this cookie there *must* be a combination of an oil based filler and of a water based filler. If only a water based filler were to be used the cookie would not have as long a shelf life" (emphasis added) (Col. 1, lines 49-52). "It is therefore *necessary* that there be a combination of an oil based filling and a water based filling" (emphasis added) (Col. 1, lines 57-59). Thus, Boehm *teaches away* from Conti by requiring the presence of water in its water-based filler, which Conti expressly avoids. Moreover, the present invention expressly recites that the confectionery mass is a substantially water-free fat-based material. Boehm also *teaches away* from the presently

claimed invention. One of ordinary skill in the art would thus have been dissuaded from using the filling of Boehm with the wafer of Conti because Conti discourages the use of water-based materials, while Boehm expressly requires the use of such materials.

Independent claims 1, 10 and 23 all recite a sugar wafer having a filling containing a mass of a substantially water-free fat-based confectionery material that has solidified or hardened from a molten mass. Conti does not disclose such a filling. A combination of Conti and Boehm is improperly alleged to teach the claimed filling. This is, however, clearly an improper hindsight rejection because one of ordinary skill in the art would have had no motivation to combine Conti and Boehm, or have had a reasonable expectation of success from combining disparate elements of Conti and Boehm when the two teach away from each other. Thus, claims 1, 10 and 23, as well as dependent claims 3-9 and 11-22 cannot be obvious over Conti in view of Boehm since no *prima facie* case of obviousness has been stated on the record. For the above reasons, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) has been obviated and should be reconsidered and withdrawn.

Accordingly, the entire application is now in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree with the Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

Respectfully submitted,

1/21/04
Date

Allan A. Fanucci
Allan A. Fanucci (Reg. No. 30,256)

WINSTON & STRAWN LLP
Customer No. 28765

212-294-3311